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IN THE

Supreme Court of the United States

OCTOBER TERM, 1945.

NO. [redacted] 28

ALPINE MacGREGOR, Petitioner,

v.

WESTINGHOUSE ELECTRIC & MANUFACTURING COMPANY, a Corporation, Respondent.

On Writ of Certiorari to the Supreme Court of the State of Pennsylvania.

REPLY BRIEF FOR PETITIONER.

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INDEX OF AUTHORITIES.

PAGE

De Forest Radio Co. v. General Electric Co., 283 U.S. 664 3

Ferree, E. H. Co. v. United Shoe Machinery Co., 290 U.S. 614, 290 U.S. 708 3

Holland Furniture Co. v. Perkins Glue Co., 277 U.S. 245 2

Paramount Publix Corp. v. American Tri-Ergon Corp., 294 U.S. 464 3

Waters-Pierce Co. v. Texas, 212 U.S. 86 1

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NO. 410.

ALPINE MacGREGOR, Petitioner,

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WESTINGHOUSE ELECTRIC & MANUFACTURING COMPANY, a Corporation, Respondent.

On Writ of Certiorari to the Supreme Court of the State of Pennsylvania.

REPLY BRIEF FOR PETITIONER.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Respondent's brief, under the heading "The Validity of the Patent Is Not in Issue Before This Court", p. 27, refers to this Court's decision in *Waters-Pierce Co. v Texas*, 212 U.S. 86, which is analyzed on page 42 in the appendix to respondent's brief. That case dealt with violation of state anti-trust laws and does not involve a patent question. It could hardly have any bearing on the matter of this Court's right to review the question of validity in the instant case, and respondent cites no other authority in support of its contention.

Respondent's brief further asserts that the Supreme Court of Pennsylvania indicated that if it found the trial court had erred in not permitting an attack upon validity of the Jones patent, it would have remanded the case to the lower court for a trial of that issue. This statement is confusing because this view of the Court below was urged by respondent in that Court, which merely said (R. 235):

> "The trial court did not pass on the validity of the patent. Appellee concedes that if failure to pass on the validity of the patent was error, a new trial should be ordered and no other question need be decided in this court."

The lower court did decide the question of validity of the Jones patent on the merits and contrary to the applicable decisions of this Court. On page 14 of our main brief we have quoted the trial court's holding (R. 171):

> "The plaintiff introduced evidence to establish the fact that the prior art does not disclose the Jones solder and that even though Gulliver in his textbook—'Metallic Alloys—1913' commented upon an alloy made of copper and phosphorus that was no bar to patentable invention making new use of such old material."

That holding proposes to pass on the merits of validity and is contrary to the decisions of this Court as pronounced by Mr. Chief Justice Stone in *Holland Furniture Co. v. Perkins Glue Co.*, 277 U.S. 245 and the cases we have cited beginning page 14 of our main brief.

This Court has jurisdiction to review the question of the patent's validity not alone as ancillary to the question of legality of the license contract, but on the

merits if that question has been decided by the Court below in a manner contrary to the applicable decisions of this Court.

This Court has found occasion to review the question of validity of patents where there was no conflict of decisions and where that issue was of some special significance.

In *E. H. Ferree Co. v. United Shoe Machinery Co.*, 290 U.S. 614, 290 U.S. 708, the Court issued certiorari involving ordinary issues of validity where the Circuit Court of Appeals seemed clearly to have exceeded its proper scope of review.

In *De Forest Radio Co. v. General Electric Co.*, 283 U.S. 664, certiorari was granted because the Court had failed to apply settled principles of law in adjudicating the validity of patents.

In *Paramount Publix Corporation v. American Tri-Ergon Corporation*, 294 U.S. 464, certiorari was issued where validity of the patent had erroneously been adjudicated even though there was no conflict of decisions.

That a state court has the right to consider and decide the question of validity of patents where it arises collaterally to some other issue before the court is beyond dispute, nevertheless the issue of validity of patents arises under the Patent Laws, and this Court has jurisdiction to review that question under Section 237 (b) of the Judicial Code, 28 U.S.C. 344 if, as here, the state court has decided that question in conflict with this Court's decisions.

There is no reason to believe and none appears from the lower court's opinions that the court below would

be of a different view if this case were remanded for determination of the question of validity of the patent.

The lower court's view was adopted by the Supreme Court of Pennsylvania which affirmed the trial court's opinion *in toto* even though that court may have had a doubt as to the validity of the Jones patent when it declared that because in its view the *Sola* case was not applicable to the case at bar—

> "We therefore do not propose to declare the Jones patent invalid."

We believe that the question of validity as here presented, like in those cases we have referred to, is one of such special circumstances that this Court is justified in reviewing it now. If the case is remanded for trial on the question of validity of the patent and the patent held valid, petitioner could not again seek a review of this case by this Court because the patent has expired.

There can be no conflict of decisions and there is no public interest, as in an unexpired patent, which would justify this Court in granting certiorari a second time. Under such circumstances the lower court, by erroneously holding the patent valid as it has already proposed to do, would lend its aid to the enforcement of a federal violation which is condemned by this Court in the *Sola* case and would thereby enforce a contract that is contrary to public policy.

Respectfully submitted,

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